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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN BRADY

Appeal 2009-003979
Application 09/228,109
Technology Center 3700

Decided: February 24, 2010

Before: WILLIAM F. PATE, III, JENNIFER D. BAHR, and LINDA E. HORNER, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Martin Brady (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 3, 7, and 10-13. The Examiner has indicated that claims 4, 5, 8, 9, 14, and 15 are allowable. Claims 1, 2, and 6 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to a kitchen opening appliance. Spec. 1:4-5. Claim 3, reproduced below, is illustrative of the claimed invention.

3. A household opening appliance comprising an electric can opener having a housing, a jar opener mounted on a bottom wall of said housing, a sheath for a scissors, and a scissors holder within said sheath.

The Rejections

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|---------|-----------------|---------------|
| Newman | US 2,720,189 | Oct. 11, 1955 |
| Davies | US 4,152,831 | May 8, 1979 |
| Zallo | US 5,494,176 | Feb. 27, 1996 |
| Nielsen | US 5,791,608 | Aug. 11, 1998 |
| Zelson | US 6,253,662 B1 | Jul. 3, 2001 |

PRESTO™ Under Cabinet Automatic Can Opener Plus, 4-11 (Nat'l PRESTO™ Indus., Inc. 1989).

Appellant seeks review of the Examiner's rejections under 35 U.S.C. § 112, second paragraph, of claims 11 and 13 as indefinite, and under § 103(a) of claims 3, 7, and 10-13 as unpatentable over PRESTO™, Davies, and Nielsen, with further evidence provided by Zallo and Newman; of claims 3, 7, and 10-13 as unpatentable over PRESTO™ and Newman; and of claim 10 as unpatentable over PRESTO™ and Zelson¹.

SUMMARY OF DECISION

We AFFIRM.

ISSUES

The Examiner concluded that claims 11 and 13 are indefinite because the Specification and claim 3 specify a housing having a sheath for scissors with a particular holder structure that requires the sheath, whereas claims 11 and 13 further limit a housing having a scissors holder by further specifying that the housing includes a sheath. Ans. 3-4, 9-10. Appellant argues that one of ordinary skill in the art would understand that the sheath is on the housing. Appeal Br. 14-15.

The Examiner concluded that claims 3, 7, and 10-13 are unpatentable over PRESTO™, Davies, and Nielsen, with further evidence provided by Zallo and Newman. Ans. 4-7, 11-12. In particular, the Examiner found that PRESTO™ describes the household opening appliance as claimed, except

¹ Appellant also presents arguments concerning the Examiner's objection of the drawings under 37 C.F.R. § 1.83(a). That issue is reviewable by petition under 37 C.F.R. § 1.181, and is not within the jurisdiction of the Board. *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967). See *Manual of Patent Examining Procedure* (MPEP) §§ 1002 and 1201.

that it does not describe a sheath for scissors. Ans. 5, 11. The Examiner then found that Davies describes a scissors sheath that can be attached to conveniently-accessible surfaces and that Nielsen teaches a scissors sheath that can be attached to a home appliance. *Id.* The Examiner also found that Zallo provides evidence that it is old and well known in the art for blade holders to reside underneath a cabinet, for safety reasons, and that Newman provides evidence that it is old and well known in the art for apparatus generally not associated with scissors (*e.g.*, thermometer, paperweight, pencil holder) to nonetheless incorporate a scissors holder in order to make the scissors more handy. Ans. 6-7, 11-12. Thus, given all of the evidence that it was known in the art to include scissor holders in convenient locations, the Examiner concluded that it would have been obvious to provide a scissors and sheath for a scissors on a surface of an appliance where such scissors and sheath might be deemed useful. Ans. 5-6. According to the Examiner, a person of ordinary skill in the art would have reason to pursue the known options within their technical grasp. Ans. 6. Appellant argues that there is no teaching, suggestion, or motivation for incorporating a scissors holder/sheath into the PRESTO™ opening device. Appeal Br. 16-27. Appellant separately argues claims 10 and 12 as one group, and claims 11 and 13 as another group. However, these arguments are repetitive of the arguments presented with respect to claims 3 and 7.

The Examiner concluded that claims 3, 7, and 10-13 are unpatentable over PRESTO™ and Newman. Ans. 7-8, 12-13. In particular, the Examiner found that PRESTO™ discloses a household opening appliance as claimed, except for a sheath and holder for scissors. Ans. 7, 13. The Examiner then found that Newman teaches that it is well known in the art to incorporate a

sheath or holder on a housing for releasably retaining scissors on the back of various structures not generally associated with scissors. *Id.* Therefore, the Examiner concluded that it would have been obvious to modify the PRESTO™ opening appliance with Newman's holder/sheath to combine known elements by known methods with no change in their respective function. Ans. 7-8, 13. Appellant argues that there is no suggestion in the prior art to combine the references. Appeal Br. 28-31. Appellant separately argues claims 10 and 12 as one group, and claims 11 and 13 as another group. However, these arguments are repetitive of the arguments presented with respect to claims 3 and 7.

The Examiner concluded that claim 10 is unpatentable over PRESTO™ and Zelson. Ans. 8, 13-14. In particular, the Examiner found that PRESTO™ discloses a household opening appliance as claimed, except for a housing capable of releasably retaining scissors on the housing. Ans. 8. Next, the Examiner found that Zelson describes that it is well known in the art to incorporate a drawer on a housing, the drawer capable of releasably retaining scissors. Ans. 8, 14. Therefore, the Examiner concluded that it would have been obvious to modify the PRESTO™ opening appliance with Zelson's drawer to combine known elements by known methods with no change in their respective function. *Id.* Appellant argues that Zelson does not suggest a scissors holder on a can opener, and that incorporating Zelson's drawer in the PRESTO™ opening appliance would render the jar opener of PRESTO™ unusable. Appeal Br. 32-33.

Therefore, the issues presented in this appeal are:

- (1) Has the Examiner erred in concluding that claims 11 and 13 are indefinite in view of the Specification's description of the relationship between a sheath and a holder?
- (2) Has the Examiner erred in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the scissors holder of Davies, given the teachings of Nielsen, Newman, and Zallo describing the benefits of keeping scissors accessible?
- (3) Has the Examiner erred in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the scissors holder of Newman, on the basis that Newman does not suggest incorporating scissor holders in opening appliances?
- (4) Has the Examiner erred in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the drawer of Zelson, given that Zelson describes a drawer mounted on the bottom of a coffee maker, which could interfere with the bottom-mounted jar opener of PRESTO™?

FACTS PERTINENT TO THE ISSUES
(FINDINGS-OF-FACT (FF))

FF1 As described in Appellant's Specification, scissors holder 58 is made of clamp members 60 and 62, respectively mounted on the rear wall 23B of housing 16 and cover member 54 of sheath 50. Spec. 5:18-24, fig. 3. In other words, clamp member 60 is mounted directly to housing 16, and clamp member 62 is mounted indirectly to housing 16, via the cover member 54 of sheath 50.

FF2 Nielson describes a scissors holder that allows users to "keep scissors ... and other hand tools within reach while keeping their work space clear" and to "store their most used tools ... on accessible surfaces." Col. 2, ll. 25-34.

FF3 Newman describes a holder for office utilities, including scissors, to make these items handy and easy to remove. Col. 2, ll. 33-42.

FF4 PRESTO™ describes an opening device for use in a kitchen having several opening gadgets, including a jar opener that is located on the bottom of the opening appliance. Pg. 8, fig. J.

FF5 Zelson describes an integral or attached compartment for holding various-sized coffee filters conveniently at the top, bottom, or side of a coffee maker. Col. 4, ll. 20-32 (drawer on bottom), col. 4, l. 66 to col. 5, l. 22 (hinge on top or half of top), col. 6, ll. 18-33 (drawer or hinge on side), col. 7, ll. 18-23 (integral or attached).

PRINCIPLES OF LAW

Indefiniteness

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

"[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112, fourth paragraph.

Obviousness

While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Further, the Supreme Court notes "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." *Id.* at 421 (internal citations omitted).

Finally, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417.

Analogous Art

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* "Under the correct

analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 420.

ANALYSIS

Issue (1) - Definiteness of Claims 11 and 13

Appellant argues that one of ordinary skill in the art would understand that the sheath is on the housing. Appeal Br. 14-15. Claims are interpreted in light of the Specification as well as the claims from which they depend.

In re Johnson, 558 F.2d at 1015; 35 U.S.C. § 112, fourth paragraph. As described in the Specification, clamp member 60 is mounted directly to housing 16, and clamp member 62 is mounted indirectly to housing 16, via the cover member 54 of sheath 50. FF1. Further, Appellant's Specification describes the scissors holder 58 as being made of clamp members 60 and 62. *Id.* Thus, the recitation of "a scissors holder on said housing" in claim 10, from which both claims 11 and 13 depend, and of a sheath for a scissors on said housing, in claims 11 and 13, is consistent with Appellant's description of the scissors holder 58, as well as with claim 3, which recites a sheath and a scissors holder within the sheath. While the clamp member 62 is mounted to cover member 54 of sheath 50, clamp member 62, like clamp member 60, is distinct from the sheath. As such, the recitation of a sheath as an additional element, distinct from the earlier-recited scissors holder, in claims

11 and 13, is not inconsistent with the underlying disclosure, and does not render these claims indefinite.²

*Issue (2) - Obviousness of Claims 3, 7, and 10-13 in view of PRESTO™,
Davies, and Nielson*

Appellant argues that there is no teaching, suggestion, or motivation for incorporating a scissors holder/sheath into the PRESTO™ opening device. Appeal Br. 16-27. However, the Supreme Court has explicitly rejected the application of a rigid formula insisting on a teaching, suggestion, or motivation (TSM) to demonstrate obviousness. *See KSR*, 550 U.S. at 415 ("[w]e begin by rejecting the rigid [TSM] approach of the Court of Appeals."). Instead, "a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. As the Examiner reasoned, Davies' scissors holder would improve the PRESTO™ can opener by making scissors readily available, which is described as a desirable feature in Nielson. Ans. 5-6.

In particular, Nielson describes a scissors holder that keeps the scissors within reach while keeping the work space clear. FF2. Newman describes a similar application of a scissors holder, wherein a scissors holder is incorporated into commonplace desk accessories. FF3. Thus, the Examiner has provided ample evidence that the adaptation of a scissors holder into various objects and locations is a desired feature and within the level of ordinary skill in the art. Therefore, modifying the PRESTO™

² Our conclusion is consistent with that reached by the Board in the first appeal in this application. *Ex parte Brady*, Appeal No. 2001-1477, On Request for Rehearing (BPAI Aug. 23, 2002).

opening appliance to include the scissors holder in Davies is nothing more than applying a technique used to improve the usability of one device and improving a similar device in the same way, which involves nothing more than ordinary creativity well within the technical grasp of a person of ordinary skill in the art. *See KSR*, 550 U.S. at 417.

Appellant further argues that the references used by the Examiner are "diverse." Appeal Br. 22. To the extent that Appellant may be arguing that the references are non-analogous art, we note that the Examiner has identified prior art that serves to make common household tools more accessible. *See id.* Thus, the prior art references identified by the Examiner are directly related to the problem Appellant's invention seeks to solve. *See id.* at 420; Spec. 2:6-8 ("an object of this invention is to provide ... several tools conveniently accessible and useable").

Therefore, Appellant has not demonstrated that the Examiner erred in concluding that claims 3 and 7 are unpatentable in view of PRESTO™, Davies, and Nielsen, with further evidence provided by Zallo and Newman. Appellant's line of reasoning with respect to the Examiner's rejection of claims 10-13 is likewise unpersuasive.

Issue (3) - Obviousness of Claims 3, 7, and 10-13 in view of PRESTO™ and Newman

Appellant does not allege any particular error in the Examiner's conclusion of obviousness with respect to this rejection, only pointing out that there is no suggestion in either reference to place a sheath on the back of a housing. Appeal Br. 28-31. Contrary to Appellant's assertion that *KSR* does not have "any bearing" on the Examiner's conclusion of obviousness,

the Supreme Court has explicitly rejected the application of a rigid formula insisting on a teaching, suggestion, or motivation (TSM) to demonstrate obviousness. *See KSR*, 550 U.S. at 415.

Newman describes a holder for office utilities, including scissors, to make these items handy and easy to remove. FF3. PRESTO™ describes an opening device for use in a kitchen having several opening gadgets, including a jar opener that is located on the bottom of the opening appliance. FF4. Similar to the rejection discussed in Issue (2), the Examiner concluded that it would have been obvious to include the scissors sheath and holder of Newman in the opening appliance of PRESTO™ because the combination would be combining known elements by known methods with no change in their respective function. Ans. 7-8. Indeed, the Supreme Court noted that a "patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." *KSR*, 550 U.S. at 415-16 (internal quotations and citation omitted); *see also Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 60-62 (1969) (holding obvious a device combining two pre-existing elements doing no more together than they would if separate). Appellant has not attempted to challenge the Examiner's particular reasoning for combining the references as proposed, nor has Appellant shown that combination of the claimed known elements is outside the realm of ordinary skill. *See KSR* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton."); *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985) (one of ordinary skill in the art is presumed to have skills apart from what the prior art references expressly disclose).

Therefore, Appellant has not demonstrated that the Examiner erred in concluding that claims 3 and 7 are unpatentable in view of PRESTO™ and Newman. Appellant's line of reasoning with respect to the Examiner's rejection of claims 10-13 is likewise unpersuasive.

Issue (4) - Obviousness of Claim 10 in view of PRESTO™ and Zelson

Appellant argues that Zelson does not suggest a scissors holder on a can opener. Appeal Br. 32-33. As noted above, the Examiner need not provide an explicit suggestion to combine the references. *See KSR*, 550 U.S. at 415. Appellant has not addressed the Examiner's reasoning for concluding that the proposed modification would have been obvious, namely, that the modification is nothing more than the combination of known elements with no change in their respective functions and would have yielded predictable results (Ans. 8). An improvement that is nothing more than the predictable use of prior art elements according to their established functions is likely to be obvious. *KSR*, 550 U.S. at 417. Thus, Appellant has not demonstrated error in the Examiner's rationale for combining the opening appliance of PRESTO™ and the drawer of Zelson.

Appellant next argues that incorporating Zelson's drawer in the PRESTO™ opening appliance would render the jar opener of PRESTO™ unusable. Appeal Br. 33. This argument is not convincing. First, claim 10 does not require a jar opener. Thus, even if the incorporation of Zelson's drawer, in the manner addressed by Appellant required the elimination of the PRESTO™ jar opener, the proposed combination would meet the limitations of claim 10. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability); *see also*

Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) ("The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.").

Moreover, Appellant's argument overlooks Zelson's teaching of alternative locations for the drawer. Claim 10 does not require that the scissors holder be disposed on the bottom of the appliance. While the PRESTO™ jar opener is located on the bottom of the opening appliance, and requires access to the bottom of the can opener for operation (FF4), Zelson's drawer can be mounted on the top, sides, or bottom of that appliance (FF5). In order for the PRESTO™ jar opener to remain usable, the incorporation of Zelson's drawer merely must not interfere with access to the jar opener on the bottom of the can opener, such as by being in any of the many configurations offered in Zelson. *See FF5.* Therefore, Appellant has not demonstrated that the Examiner erred in concluding that the subject matter of claim 10 is obvious in view of PRESTO™ and Zelson.

CONCLUSIONS

- (1) The Examiner erred in concluding that claims 11 and 13 are indefinite.
- (2) The Examiner did not err in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the scissors holder of Davies, given the teachings of Nielsen, Newman, and Zallo describing the benefits of keeping scissors accessible. Thus,

the Examiner did not err with respect to the rejections of claims 3, 7, and 10-13 as unpatentable over PRESTO™, Davies, and Nielson.

(3) The Examiner did not err in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the scissors holder of Newman, on the basis that Newman does not suggest incorporating scissor holders in opening appliances. Thus, the Examiner did not err with respect to the rejections of claims 3, 7, and 10-13 as unpatentable over PRESTO™ and Newman.

(4) The Examiner did not err in concluding that it would have been obvious to modify the opening appliance of PRESTO™ to include the drawer of Zelson, despite the fact that Zelson describes a drawer mounted on the bottom of a coffee maker that could interfere with the jar opener in PRESTO™. This is the case because Zelson also teaches other locations for the drawer. Thus, the Examiner did not err with respect to the rejection of claim 10 as unpatentable over PRESTO™ and Zelson.

DECISION

The Examiner's decision is affirmed as to claims 3, 7, and 10-13. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2009-003979
Application 09/228,109

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